

biocompatible is taught, “so long as they are completely encapsulated by the surrounding structural elements and thus do not contact living tissue.” While the elements have the characteristic of being inherently structural, this is taught by Applicant as a limitation and characteristic of the circuit.

Claims 3-15 are not specifically objected to and depend from claim 1 as further limitations.

Claims 1 and 9-12 are rejected under 35 USC 103(a) as being unpatentable over Manley (US Pat. No. 3,977,392) in view of Taylor (US Pat. No. 5,067,491).

Claim 1 is an independent claim and claims 9-12 depend from claim 1.

The Examiner admits that Manley fails to teach polymer layers of polyparaxylylene. Additionally, Manley fails to teach a “structural” device. Also, no polymer is taught and Manley’s “soft compliant layer 22” is not a second polymer layer, rather it is taught to be a ‘nonporous closed cell material,’ that is, it is a closed cell foam material. “Thin vinyl plastic 36” is not a first polymer layer, although Manley teaches that it is nonporous. The “opening 24” is filled with “gel pad 26” [the gel pad 26 must be kept moist to serve as an electrical conductor] and thus opening 24 is not an aperture [a wet-conductor filled aperture can’t expose the “foil strip 28”] and it is not “exposing said electrical conductor,” as claimed by Applicant. [Applicant claim 1]

Additionally, Manley does not teach an implantable device. Rather it is a device that is placed external to the living tissue and in contact with the skin.

Not only does Manley teach no “polymer layers of polyparaxylylene,” Manley teaches no specific materials selections [except for a silver] for the external electrode, perhaps because this disposable single-use electrode device is not suitable to be implanted.

Looking to Taylor to remedy these deficiencies, we find that Taylor teaches parylene coated on a catheter. However, the deficiencies discussed above in the Manley patent remain to be taught. Combining Manley and Taylor does not render applicant’s claims 1 obvious.

Claims 9-12 are allowable as additional limitations on an allowable

independent claim 1.

Claims 1-14 are rejected under 35 USC 103(a) as being unpatentable over Berrang (US Pat. Pub. 2003/0109903).

Claim 1 is an independent claim and claims 3-14 depend from claim 1 [claim 4 depends from claim 3; claim 6 depends from claim 5; claim 8 depends from claim 7; and claim 13 depends from claim 12].

Claim 2 has been previously cancelled.

This rejection is the second of three identical rejections [based on different and distinguishable prior art references] of claims 1 as well as claims 9-12.

The Examiner is requested to be specific in the citation to the prior art references. Please note that, "In rejecting claims for want of novelty or for obviousness, the examiner must cite the best references at his or her command. When a reference is complex or shows or describes inventions other than that claimed by the applicant, the particular part relied on must be designated as nearly as practicable." [MPEP 706; 707; 37 CFR 1.104(c)(2)]

Additionally, in rejecting claims for want of novelty or for obviousness, the examiner must cite the best references at his or her command. When a reference is complex or shows or describes inventions other than that claimed by the applicant, the particular part relied on must be designated as nearly as practicable. The pertinence of each reference, if not apparent, must be clearly explained and each rejected claim specified. 37 CFR 1.104 (c) (2)

Here, the Examiner rejects these cited claims based on multiple redundant references and avoids selecting the best prior art, instead requiring multiple redundant arguments for allowance over references that are clearly distinguishable and not particularly relevant to the issue at hand.

The Examiner finds that Berrang alone teaches enough of Applicant's claimed invention to render it obvious when modified with polyparaxylylene and polyimide because the results are predictable. There is limited citation to teaching of Applicant's invention relying mainly on reference to Fig. 1 of Berrang. A specific reference to specifically where the particular teaching occurs in Berrang is

requested.

After a diligent search of Berrang, Applicant finds no teaching to polyparaxylylene. Additionally the device taught by Berrang is not flexible, as is taught and claimed by Applicant. Berrang teaches a rigid device having biocompatible metal plates. While there is teaching of an “aperture,” it is not listed with a reference numeral in Berrang and it is not the “small polymer lip 14” that is taught by Berrang.

The Examiner is relying on personal knowledge to support the finding of what is known in the art, the Examiner must provide an affidavit or declaration setting forth specific factual statements and explanation to support the findings. See 37 CFR 1.104(d)(2). MPEP 2144.03 C.

“The proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959).” MPEP 2143.01 VI.

Additionally, “If proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984). MPEP 2143.01 V.”

Modifying the invention of Berrang as proposed, to make it flexible, is not the correct standard to prove obviousness.

Additionally, while Berrang teaches fluoropolymer layers 9, 10, 11, and 12, an aperture is possibly defined by “small polymer lip 14.” Berrang does not teach that the aperture is defined by the deposited second layer. He teaches that a lip 14 is formed of layer 12. Second layer 11 is on the opposite [non-aperture] side of layer 12 in Berrang.

The Examiner declares that the results of optimizing the insulation properties are predictable. However, this is hindsight reasoning.

The burden of establishing a *prima facie* case of obviousness thus rests upon the Examiner and can only be satisfied by showing an objective teaching in the prior art or by knowledge generally available to one of ordinary skill in the art

that would have led such individual to combine the relevant teachings of the cited references. It is error to reconstruct the appellant's claimed invention from the prior art by using the appellant's claim as a "blueprint". When prior art references require selective combination to render a subsequent invention unpatentable for obviousness, there must be some reason for the combination other than the hindsight obtained from the invention itself. See *Interconnect Planning Corp. v. Feil*, 774 F.2d 1132, 227 U.S.P.Q. 543 (Fed. Cir. 1985). For the reasons discussed, the prior art reference cited by the Examiner in combination with what is declared to be obvious do not suggest the invention, as a whole, defined by claim 1 in the above-captioned application.

"To prevent the use of hindsight based on the invention to defeat patentability of the invention, this court requires the Examiner to show a motivation to combine the references that create the case of obviousness". *In Re Rouffet*, 149 F.3d 1350, 47 U.S.P.Q. 2d 1453 (Fed. Cir. 1998). "(T)he suggestion to combine requirement stands as a critical safeguard against hindsight analysis and rote application of the legal test for obviousness". *In Re Rouffet*, supra.

Claims 3-14 are allowable as further limitations on an allowable claim 1.

Claims 1-14 are rejected under 35 USC 103(a) as being unpatentable over Berrang in view of Taylor.

Claim 1 is an independent claim and claims 3-14 depend from claim 1 [claim 4 depends from claim 3; claim 6 depends from claim 5; claim 8 depends from claim 7; and claim 13 depends from claim 12].

Claim 2 has been previously cancelled.

The numerous deficiencies in the teachings of Berrang are discussed above and the discussion is incorporated here without reproducing it.

Taylor does not teach the device being flexible, as is taught and claimed by Applicant. Berrang teaches a rigid device having biocompatible metal plates. While there is teaching of an "aperture," it is not listed with a reference numeral in Berrang and it is not the "small polymer lip 14" that is taught by Berrang. Taylor does not cure these deficiencies. As discussed above, Taylor teaches parylene

coated on a catheter.

Taylor does not cure these many deficiencies and the combination of Berrang and Taylor does not render claim 1 obvious.

Claims 3-14 are allowable as further limitations on an allowable claim 1.

Claim 15 is rejected under 35 USC 103(a) as being unpatentable over Berrang in view of Strandberg (US Pat. No. 5,476,496).

Claim 15 is allowable as a further limitation on allowable claims 1 and 14, from which it depends.

In view of all of the foregoing, reexamination and allowance are respectfully requested.

Applicant respectfully requests that a timely Notice of Allowance be issued in this case. If for any reason the Examiner finds the application other than in condition for allowance, the Examiner is requested to call the undersigned attorney at the Los Angeles, California area telephone number (661) 803-2622 to discuss the steps necessary for placing the application in condition for allowance.

Respectfully submitted,

5/19/10

Date

/Gary Schnittgrund/

Gary Schnittgrund
Attorney for Applicant
Reg. No. 42,130

Second Sight Medical Products, Inc.
12744 San Fernando Rd
Building 3
Sylmar, CA 91342
(818) 833-5055